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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Family Dollar Marketing, Inc.

Serial No. 75/699,535

Francis M. Pinckney of Kennedy Covington Lobdell & Hickman
for applicant.

Daniel F. Capshaw, Trademark Examining Attorney, Law Office
109 (Ronald Sussman, Managing Attorney).

Before Quinn, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Family Dollar Marketing, Inc. has filed an application
to register the mark GABRIELLE INTIMATES for "ladies
sleepwear, camisole and party sets wherein each set is
comprised of a camisole and a panty."¹

The Trademark Examining Attorney has finally refused
registration under Section 2(d) of the Trademark Act, 15

¹ Serial No. 75/699,535 filed May 7, 1999, based on an allegation
of a bona fide intention to use the mark in commerce. The word
"INTIMATES" has been disclaimed apart from the mark as shown.

U.S.C. §1052(d), in view of the prior registration of GABRIELLE, shown below, for "hosiery; ladies', misses' and children's slips, panties, pajamas, [and] nightgowns."²



Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the goods and the similarities between the marks. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

² Registration No. 818,708 issued November 15, 1966; affidavits under Sections 8 and 15 accepted and acknowledged, respectively; renewed.

Considering first the goods, the Examining Attorney contends that the ladies' and misses' panties in the cited registration and applicant's ladies' camisole and panty sets are nearly identical and that in the case of the remaining goods in the cited registration, such goods are closely related to applicant's goods. Applicant does not contend otherwise and, in fact, makes no mention of the goods in its brief on the case. Thus, we consider applicant to have conceded that the goods are nearly identical and otherwise closely related. Further, in the absence of any limitations or restrictions in applicant's application and the cited registration with respect to channels of trade and purchasers, we must presume that applicant's and registrant's goods move in all the normal channels of trade to all the usual purchasers. Thus, in this case, we must assume that both applicant's and registrant's goods would be sold in department stores, specialty stores and mass merchandisers to ordinary consumers.

We turn then a consideration of the marks. The Examining Attorney contends that the GABRIELLE portion of applicant's mark is dominant; that the INTIMATES portion of applicant's mark is descriptive/generic of applicant's

goods; and that applicant's and registrant's marks are, thus, substantially similar.

Applicant, on the other hand, contends that its mark is sufficiently different from the cited mark to prevent consumer confusion. In particular, applicant points out that its mark is in typed drawing form whereas the cited mark is in a stylized drawing form; and that its mark contains the additional term INTIMATES which serves to distinguish the marks. Further, applicant argues that marks containing the name GABRIELLE (and variations thereof, e.g. GABRIEL and GABRIELLA) are weak marks, which are therefore entitled to only a limited scope of protection. Specifically, applicant maintains that the name GABRIELLE (and variations thereof) is so frequently used in marks for clothing that where as here, applicant's mark contains the additional term INTIMATES, the mere inclusion in the marks of the name GABRIELLE is an insufficient basis on which to find a likelihood of confusion.

In this case, we find that applicant's mark and the cited mark, when viewed in their entirety, create substantially similar commercial impressions. Both marks begin with GABRIELLE, and in the cited mark GABRIELLE is followed by the term INTIMATES, which is clearly

descriptive and which has been disclaimed. Although marks must be considered in their entirety, it is well established that there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The name GABRIELLE is clearly the dominant feature in applicant's mark. In view of the descriptiveness of the term INTIMATES, it is the name GABRIELLE which has source-identifying significance. Thus, the dominant feature in applicant's mark is identical to the cited mark GABRIELLE in its entirety. We note that it is a general rule that a subsequent user may not appropriate another's entire mark and avoid a likelihood of confusion simply by adding descriptive or subordinate matter thereto. See *Alberto-Culver Company v. Helene Curtis Industries, Inc.*, 167 USPQ 365 (TTAB 1970).

In addition, the slight stylization of the cited mark does not serve to distinguish the marks so as to avoid a likelihood of confusion. We should also point out that because applicant's mark is in typed drawing form, applicant would be free to depict its mark in a manner, which is similar or even identical to the cited mark.

Finally, we turn to applicant's argument that marks containing the name GABRIELLE (and variations thereof) are weak marks. In support thereof, applicant submitted with its response to the Examining Attorney's first Office action, copies of of six third-party registrations containing the name GABRIELLE or a variation thereof all for items of clothing. In addition, applicant submitted with its brief on the case, a list of four additional third-party registrations containing the name. The Examining Attorney has properly objected to the list of third-party registrations in applicant's brief. As correctly pointed out by the Examining Attorney, the Board does not take judicial notice of registrations which reside in the U.S. Patent and Trademark Office and the submission of a mere list of third-party registrations is insufficient to make them properly of record. Moreover, under Trademark Rule 2.142(d), "evidence" submitted for the first time with a brief on appeal is normally considered by the Board to be untimely and therefore given no consideration. In view thereof, we will not consider the third-party registrations listed in applicant's brief in reaching our decision herein.³

³ We hasten to add that even if we had considered these registrations, our decision herein would be the same.

As to the third-party registrations properly of record, three of these registrations consist of GABRIEL(E) as a surname in association with a given name; two of the registrations consist of GABRIELLA as a given name in association with a surname; and the remaining registration consists of GABRIELLE as a given name in association with another given name.⁴ While these registrations suggest that a registration of a full name or "combination" of names containing either the given name or surname GABRIELLE (or a variation thereof) will not be a bar to subsequent registration of other marks in the clothing field consisting of this name in association with different given names or surnames, this is not the case before us. In other words, applicant's mark does not consist of GABRIELLE and a given name or surname. Rather, as noted above, applicant's mark consists of GABRIELLE and a descriptive term.

In sum, based on the substantial similarity in the marks, the near identity and relatedness of the goods, and the identical trade channels and purchasers, we find that

⁴ The marks in these registrations are: CHARLES GABRIELE, JOSEPH GABRIEL, GINA GABRIEL, GABRIELLA TORELLI, GABRIELLA FRATTINI, and GYD GABRIELLE-YVAN MOTHER DAUGHTER DESIGNS.

there is a likelihood that the relevant purchasing public would be confused when applicant uses the mark GABRIELLE INTIMATES for ladies' camisole and party sets wherein each set is comprised of a camisole and a panty in view of the previously registered mark GABRIELLE in stylized form for hosiery; ladies', misses', and children's slips, panties, pajamas and nightgowns. In particular, purchasers familiar with registrant's clothing items offered under the stylized mark GABRIELLE, upon encountering camisole and panty sets offered under the mark GABRIELLE INTIMATES are likely to believe that this is a new line of clothing offered by registrant.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.